

May 27, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re SRO Management, LLC

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Serial No. 76236222

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David V. Radack for SRO Management, LLC.

Martha L. Fromm, Trademark Examining Attorney, Law Office  
106 (Mary I. Sparrow, Managing Attorney).

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Before Hanak, Hohein and Bottorff, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

SRO Management, LLC (applicant) seeks to register on  
the Principal Register in typed drawing form THE  
CONTINENTAL RESTAURANT & MARTINI BAR for "restaurant and  
bar services." The application was filed on April 5, 2001  
with a claimed first use date of September 1995.

Citing Section 2(e)(1) of the Trademark Act, the  
Examining Attorney refused registration on the basis that  
applicant's mark is a generic phrase for applicant's  
services. When the refusal to register was made final,  
applicant appealed to this Board. Applicant and the

Examining Attorney filed briefs. Applicant did not request a hearing.

At the outset, a review of the history of this prosecution is in order. In the first office action, the Examining Attorney refused registration solely on the basis that applicant's mark was merely descriptive of applicant's services pursuant to section 2(e)(1) of the Trademark Act. However, at the conclusion of this first office action, the Examining Attorney stated as follows: "The proposed mark appears to be generic as applied to the services. ... Under these circumstances, the Examining Attorney cannot recommend an amendment to proceed under Trademark Act Section 2(f) ... or an amendment to the Supplemental Register." (emphasis added).

In response, applicant made two salient points. First, applicant stated that it wished to disclaim the exclusive right to the term RESTAURANT & MARTINI BAR apart from the mark in its entirety. Second, applicant stated that its mark had become distinctive of its services pursuant to Section 2(f) of the Trademark Act by virtue of applicant's continuous use of this mark for over five years. In support of this latter statement, applicant submitted the declaration of Stephen Starr, applicant's manager. Next to applicant's disclaimer, the Examining

Attorney wrote in bold lettering DO NOT PRINT. However, it is clear that applicant voluntarily offered this disclaimer with no restrictions attached. Accordingly, this disclaimer is of record and will appear if the application is published for opposition purposes.

In the second office action, the Examining Attorney refused registration solely on the basis that applicant's mark as applied to applicant's services was generic. The Examining Attorney did not discuss applicant's evidence of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act.

In response, applicant submitted additional evidence demonstrating that its mark had become distinctive of its services. Applicant demonstrated that its restaurant had received PLAYBOY Magazine's "Best Bar" Award. Moreover, applicant demonstrated that FOOD AND WINE Magazine awarded applicant's restaurant its "Best Chef" Award. Finally, applicant showed that its restaurant THE CONTINENTAL RESTAURANT & MARTINI BAR had been featured in an episode of the television show "Sex in The 90's" broadcast on MTV.

In her final office action refusing registration, the Examining Attorney did not discuss any of applicant's additional evidence demonstrating that its mark had become distinctive of its services. At page 3 of the final office

action, the Examining Attorney acknowledged only applicant's claim of use of its mark "for at least five (5) years." The Examining Attorney then went on to state that the mark is generic and hence a genericness refusal "cannot be overcome with a claim of acquired distinctiveness."

To begin with, we find that the Examining Attorney's statement at page 3 of her brief that the sole issue to be decided on appeal is whether the proposed mark THE CONTINENTAL RESTAURANT & MARTINI BAR is generic is simply wrong. There are two issues on appeal. First, is applicant's mark generic? Second, if not, has applicant's merely descriptive mark acquired distinctiveness?

In considering whether applicant's mark is generic it is beyond dispute that "the burden of showing that a proposed trademark [or service mark] is generic remains with the Patent and Trademark Office." In re Merrill Lynch, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Moreover, it is incumbent upon the Examining Attorney to make a "substantial showing ... that the matter is in fact generic." Merrill Lynch, 4 USPQ2d at 1143. Indeed, this substantial showing "must be based on clear evidence of generic use." Merrill Lynch, 4 USPQ2d at 1143. Thus, "a strong showing is required when the Office seeks to establish that a [mark] is generic." In re K-T Zoe

Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). Moreover, any doubt whatsoever on the issue of genericness must be resolved in favor of the applicant. In re Waverly Inc., 27 USPQ2d 1620, 1624 (TTAB 1993).

When a mark consists of a phrase, as does applicant's mark, it is clear that "the Board cannot simply cite definitions and generic uses of the constituent terms of a mark ... in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole to hold a mark ... generic." In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). Continuing, the Court stated that "the Board applied an incorrect legal test to the evidence before it, ruling the disputed phrase of the mark generic as a whole based solely on evidence that its constituent elements, 'society' and 'reproductive medicine,' were generic." American Fertility, 51 USPQ2d at 1837.

If the Examining Attorney had simply followed this clear, well established legal test set forth by the United States Court of Appeals for the Federal Circuit, she should never have refused registration, simply with the evidence she made of record, on the basis that applicant's mark, taken in its entirety, was generic. Throughout the entire

examination process and indeed in her brief, the Examining Attorney never even mentioned the American Fertility case.

We will now describe the Examining Attorney's "evidence" that THE CONTINENTAL RESTAURANT & MARTINI BAR is generic for restaurant and bar services. The Examining Attorney has made of record numerous magazine and newspaper articles where the term "martini bar" appears. Thus, she has established that the term "martini bar" is generic for a type of bar. The Examining Attorney has also made of record numerous other articles where the term "continental restaurant" appears. Thus, the Examining Attorney has established that this term is generic for restaurant services.

However, the Examining Attorney has not made of record one single article which contains both the terms "martini bar" and "continental restaurant." She has certainly not made of record any article (or other evidence) where the entire phrase THE CONTINENTAL RESTAURANT & MARTINI BAR appears. Indeed, she has not made of record one single article where the phrases CONTINENTAL RESTAURANT & MARTINI BAR or CONTINENTAL RESTAURANT MARTINI BAR appear. In short, the Examining Attorney, having failed to acknowledge American Fertility, has failed to prove that applicant's

mark THE CONTINENTAL RESTAURANT & MARTINI BAR is generic for bar and restaurant services.

Turning to the issue of whether applicant's mark has become distinctive of applicant's services, we find that it has pursuant to Section 2(f) and hence is entitled to registration. Obviously, applicant's mark is very descriptive of restaurant and bar services. As a mark's descriptiveness increases, a greater evidentiary showing pursuant to Section 2(f) is required to establish that said mark has acquired distinctiveness. Yamaha International v. Hoshino Gakki, 840 F.2d 572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988).

However, having said the foregoing, we note that applicant's restaurant has but one location in Philadelphia. As previously stated, applicant's single location restaurant has nevertheless received awards from two major national publications (Playboy and Food and Wine), and has been featured in a nationally broadcast television show ("Sex in the 90's"). Coupled with applicant's continuous use for over five years, this is a sufficient showing for a single location restaurant that its name (mark) has acquired distinctiveness.

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Decision: The refusal to register is reversed, and applicant's mark will be published for opposition purposes with a disclaimer of RESTAURANT & MARTINI BAR.